UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/470,669	12/23/1999	KELAN C. SILVESTER	42390.P8085	6426

7590   04/23/2004

DAVID KAPLAN
BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP
12400 WILSHIRE BOULEVARD
7TH FLOOR
LOS ANGELES, CA 90025

EXAMINER
VU, TRISHA U

ART UNIT	PAPER NUMBER
2112	

DATE MAILED: 04/23/2004

16

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No		Applicant(s)	
Office Action Summary	09/470,669		SILVESTER, KELAN C.	
	Examiner		**Art Unit**	
	Trisha U. Vu		2112	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _23 February 2004_ .

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1-5,7-12 and 14-20_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _1-5,7-12 and 14-20_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on _6-20-03_ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____ .

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)	4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) ☐ Notice of Informal Patent Application (PTO-152)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .	6) ☐ Other: .

DETAILED ACTION

1. Claims 1-5, 7-12, and 14-20 are presented for examination.

Claims 6, 13, and 21 had been canceled by Applicant.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-5, 7-12, and 14-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter "the notebook computer being exclusive of a CPU" which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-5, 7-9, 12, 14, and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pipes (5,999,997) in view of Flanagin et al (6,128,661) (herein after Flanagin).

As to claim 1, Pipes discloses an electrical device comprising a housing to be

docked into a notebook computer (col. 1, lines 7-8 and 48-50) having a memory to store a

first operating system (first operating system) (col. 1, lines 26-36), an interface disposed

on a surface of the housing to enable communication between the device and the

notebook computer when the device is docked (Figs. 2A and 2B); a memory to store a

second operating system (second operating system) (col. 1, lines 26-36); and a CPU

(second processing unit) to operate as a system processor of the docking computer when

the device is undocked and to operate as a system CPU of the device when the device is

undocked (col. 2, lines 4-6 and col. 5, lines 52-60). However, Pipes does not explicitly

disclose the electronic device being a PDA and the second operating system is smaller in

size and provides less functionality than the first operating system. Flanagin teaches a

PDA with an operating system (e.g. Windows CE) smaller in size and provides less

functionality than the operating system of the host computer (e.g. Windows 95, Windows

NT, etc...) (col. 6, lines 42-51 and col. 7, lines 23-38). It would have been obvious to

one of ordinary skill in the art at the time the invention was made to implement a PDA

with an operating system smaller in size and provides less functionality than the

operating system of the host computer as taught by Flanagin in the system of Pipes to

provide a more compact and portable system. However, Pipes and Flanagin do not

explicitly disclose the notebook computer being exclusive of a CPU. Elimination of an

element and its function is obvious since it has been held that omission of an element and

its function involves only routine skill in the art. *In re Karlson, 136 USPQ 233*. It would

have been obvious to one of ordinary skill in the art at the time the invention was made to

eliminate the CPU of the notebook computer to provide a less expensive system.

As to claims 2 and 4, Pipes further discloses an input controller and an output

controller to receive and output data when the device is undocked (col. 1, lines 38-40

wherein the device includes I/O devices, e.g. keyboard, monitor, or mouse, implies that

there are I/O controllers).

As to claim 3, Pipes further discloses core memory to store input data when the

device is undocked (at least memory 208) (Fig. 2B).

As to claim 5, Pipes further discloses a visual display coupled to the input/output

controller (monitor 231). Pipes fails to disclose that the visual display being coupled to

the input/output controller is via pen-based. Official notice is taken by examiner that

pen-based interface is well known in the art for using with portable computer to provide

input/output data.

As to claims 7-9, Pipes further discloses a battery to provide power to the CPU

when the device is undocked, the battery is recharged when docked, and the computer

provides power to the processor when docked (note col. 3, lines 52-57).

As to claim 12, Pipes discloses a base computer (first computer-100) comprising a

docking port to receive a computer device (second computer-200) (Figs. 2A and 2B, and

col. 1 lines 7-8) having a CPU to operate as a system CPU of the base computer when the

device is docked and to operate as a system CPU of the computer device when undocked

(col. 2, lines 4-6 and col. 5, lines 52-60), the computer device including a memory to

store a first operating system (second operating system) (col. 1, lines 26-36); an interface

in the docking port to enable communication between the computer device and the base computer when the computer device is docked (Fig. 2A and 2B); and a memory to store a second operating system (first operating system) (col. 1, lines 26-36). However, Pipes fails to disclose that the computer device is a hand-held computer and the second operating system of the base computer is larger in size and has greater functionality than the first operating system of the hand-held computer. Flanagin teaches a hand-held computer with an operating system (e.g. Windows CE) smaller in size and provides less functionality than the operating system of the host computer (e.g. Windows 95, Windows NT, etc...) (col. 6, lines 42-51 and col. 7, lines 23-38). It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement a hand-held computer with an operating system smaller in size and provides less functionality than the operating system of the host computer as taught by Flanagin in the system of Pipes to provide a more compact and portable system. However, Pipes and Flanagin do not explicitly disclose the base computer being exclusive of a CPU. Elimination of an element and its function is obvious since it has been held that omission of an element and its function involves only routine skill in the art. *In re Karlson, 136 USPQ 233*. It would have been obvious to one of ordinary skill in the art at the time the invention was made to eliminate the CPU of the base computer to provide a less expensive system.

As to claim 14, Pipes further discloses the interface is to couple a power supply of the base computer to a battery in the core computer to charge the battery and to provide power to the CPU when the core computer is docked (Fig. 2B and col. 3, lines 52-57).

As to claim 17, Pipes teaches a method of operating a computer system comprising: operating a CPU as a system CPU of a notebook computer when a core computer is docked in a docking port of the notebook computer, and operating the CPU as a system processor of the core computer when the core computer is undocked (col. 2, lines 4-6 and col. 5, lines 52-60), the notebook computer including a memory to store a first operating system (first operating system); and the core computer including a memory to store a second operating system (second operating system) (col. 1, lines 26-36). However, Pipes does not explicitly disclose the second operating system is smaller in size and provides less functionality than the first operating system. Flanagin teaches a PDA with an operating system (e.g. Windows CE) smaller in size and provides less functionality than the operating system of the host computer (e.g. Windows 95, Windows NT, etc...) (col. 6, lines 42-51 and col. 7, lines 23-38). It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement a PDA with an operating system smaller in size and provides less functionality than the operating system of the host computer as taught by Flanagin in the system of Pipes to provide a more compact and portable system. However, Pipes and Flanagin do not explicitly disclose the notebook being exclusive of a CPU. Elimination of an element and its function is obvious since it has been held that omission of an element and its function involves only routine skill in the art. *In re Karlson, 136 USPQ 233*. It would have been obvious to one of ordinary skill in the art at the time the invention was made to eliminate the CPU of the notebook to provide a less expensive system.

As to claim 18, Pipes does not explicitly disclose synchronizing memory of the notebook computer with memory of the core computer when the core computer is docked. Flanagin further discloses synchronizing memory of the notebook computer (memory 8) with memory of a docked device (memory 6) (col. 13, lines 31-35). It would have been obvious to one of ordinary skill in the art at the time the invention was made to including synchronizing memory of the notebook computer with memory of a docked device as taught by Flanagin in the system of Pipes to so that data can be updated to the latest version.

As to claim 19, Pipes further discloses charging a battery in the core computer when the core computer is docked (note col. 3, lines 52-57).

4.   Claims 10, 11, 15, and 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pipes (5,999,997) in view of Flanagin et al (6,128,661) (herein after Flanagin) and further in view of Atkinson (5,884,049).

As to claims 10 and 11, the argument above for claim 9 applies. However, Pipes and Flanagin do not explicitly disclose that the CPU is to operate at a higher frequency and a higher voltage when the device is docked than when undocked. Atkinson discloses that the processor is to operate at a higher frequency and a higher voltage when the device is docked (note the abstract and col. 1, lines 50-54). It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a higher frequency and a higher voltage as taught by Atkinson in the system of Pipes and Flanagin since this will improve the processor performance.

As to claim 15, the argument above for claim 14 applies. However, Pipes and Flanagin do not explicitly teach that the CPU is to operate at a higher frequency and at a higher voltage when the CPU operates as a system CPU of the base computer than when the CPU operates as a system processor of the core computer. Atkinson discloses that the processor is to operate at a higher frequency and a higher voltage when the device is docked (note the abstract and col. 1, lines 50-54). It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a higher frequency and a higher voltage as taught by Atkinson in the system of Pipes and Flanagin since this will improve the processor performance.

As to claim 20, the argument above for claim 17 applies. However, Pipes and Flanagin do not explicitly disclose operating the CPU at a higher frequency and voltage than when operating the CPU as a system CPU of the core computer. Atkinson teaches operating the CPU at a higher frequency and a higher voltage when the device is docked (note the abstract and col. 1, lines 50-54). It would have been obvious to one of ordinary skill in the art at the time the invention was made to operate the CPU at a higher frequency and voltage as taught by Atkinson in the system of Pipes and Flanagin since this will improve the processor performance.

5.   Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pipes (5,999,997) in view of Flanagin et al (6,128,661) (herein after Flanagin) as applied to claim 12 above, and further in view of Uehara et al. (5,754,798) (herein after Uehara).

As to claim 16, Pipes and Flanagin do not explicitly teach that the CPU is to operate in one of a high power mode and low power mode according to user preference. Uehara discloses a teaching that the processor can operate in different power mode set by the user (note col.16, lines 34-44). One ordinary skill in the art, at the time the invention was made, would have been motivated to employ different power mode for the processor as taught by Uehara in the system of Pipes and Flanagin because the user can save the power in lower mode. Otherwise, if the user needs a high CPU performance, he/she can choose the higher mode.

Response to Arguments

6.   Applicant's arguments filed 12-23-99 have been fully considered but they are not persuasive:

With respect to Applicant's argument on page 8 of the Remarks that the base computer being exclusive of a CPU, note col. 2 lines 1-6 in Pipes reference where it said "*The method also includes configuring the first and second computers to operate with one of the central processing units as a single computer*", thus it would have been obvious to one of ordinary skill in the art to eliminate one of the CPUs in the system of Pipes to reduce the cost of the system. Also, it has been held that omission of an element and its function involves only routine skill in the art. *In re Karlson, 136 USPQ 233.*

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Trisha U. Vu whose telephone number is 703-305-5959. The

examiner can normally be reached on Mon-Thur and alternate Fri from 7:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Mark Rinehart can be reached on 703-305-4815. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.
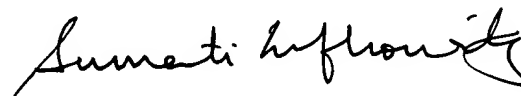
Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Trisha U. Vu
Examiner
Art Unit 2112

uv

SUMATI LEFKOWITZ
PRIMARY EXAMINER